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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,652	06/28/2006	Tadaaki Kaneko	285507US0PCT	7566
22850	7590	09/16/2011	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				LANGMAN, JONATHAN C
ART UNIT		PAPER NUMBER		
1784				
NOTIFICATION DATE			DELIVERY MODE	
09/16/2011			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/566,652	KANEKO ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	JONATHAN LANGMAN	1784

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 June 2011.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) Claim(s) 8-25 is/are pending in the application.
  - 5a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 6) Claim(s) 11, 12 and 18-20 is/are allowed.
- 7) Claim(s) 8-10, 13-17 and 21-25 is/are rejected.
- 8) Claim(s) \_\_\_\_\_ is/are objected to.
- 9) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) The specification is objected to by the Examiner.
- 11) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

<input type="checkbox"/> Notice of References Cited (PTO-892)	<input type="checkbox"/> Interview Summary (PTO-413)
<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
<input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	<input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date. _____ .	<input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Claim Objections***

Claims 8 and 13 are objected to because of the following informalities: sequence (ii) of these claims, reads: “sublimated to remove the Ta<sub>2</sub>O<sub>5</sub> and in vacuum”. This is grammatically incorrect. The “vacuum” limitation emphasized above, may better fit at the beginning of sequence (ii), so that the claims read “(ii) in vacuum, heat treating...”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-10, 13-17, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, rejected under 35 U.S.C. 103 (a) as being unpatentable over Douglass et al. (US 3,163,563).

In regards to claim 8, Douglass et al. teach an article that comprises tantalum or tantalum alloys. The article is molded to a desired shape and then carburized by known methods to provide a carbide layer of the desired thickness. The carburization takes place in a carbon crucible and in a methane atmosphere (col. 3, lines 1-20).

The applicant claims the article in a product by process form, wherein the process limitations include a vacuum heat treatment under a condition where a native oxide layer of  $Ta_2O_5$  formed on a surface of the tantalum or tantalum alloy is sublimated to remove the  $Ta_2O_5$ ; as well as heat treating the tantalum or tantalum alloy by introducing a carbon source into the vacuum heat treatment furnace to have carbon penetrate from the surface of the tantalum or tantalum alloy; wherein the tantalum carbide material comprises TaC layers formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; fibrous crystals within the same TaC layer has the same growing direction; and a growing direction of fibrous crystals within a TaC layer is different from a growing direction of fibrous crystals within a different TaC layer.

#### $Ta_2O_5$ Removal

Douglass et al. are silent to removing the native oxide layer of  $Ta_2O_5$  through sublimation.

However the examiner takes two separate positions in regards to this claim limitation in view of Douglass et al.

The first position is that the processing conditions of a vacuum heat treatment and a heat treatment while introducing a carbon source as claimed, are substantially similar processing conditions to those disclosed by Douglass et al. Even though Douglass et al. do not mention the instantly claimed removal of native oxide  $Ta_2O_5$ , it is inherent that this would occur in Douglass et al. It has been held that where the claimed and prior art products are identical or substantially identical in structure or are produced by identical or a substantially identical processes, a *prima facie* case of either

anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 ( Fed. Cir. 1990). The ***prima facie*** case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Douglass et al. teach elevated temperature heat treatments of 2300°C (Table 1) in the presence of methane and a carbon crucible in a reduced atmospheric pressure (vacuum). These processing parameters substantially overlap those process parameters instantly claimed as well as taught (instant specification page 10, lines 20-25) and therefore it is inherent that the native oxide, Ta<sub>2</sub>O<sub>5</sub>, is removed.

The second position is that these parameters of a heat treatment to remove a native oxide, as well as a heat treatment in a vacuum in the presence of a carbon source are all product by process limitations that do not structurally distinguish themselves, from the prior art.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.", (*In re Thorpe*, 227 USPQ 964,966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art,

although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product (*In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113).

The instant claims set forth a product with a final structure that comprises a tantalum carbide layer on a tantalum body with no intervening oxide. Douglass et al. do not teach an oxide layer is present. As seen in the figures there is an interface with no intervening layers between the carburized tantalum body and the tantalum carbide layers. Therefore it is the Examiner's position that the structure of Douglass et al. is the same as the structure instantly claimed, wherein little to no patentable weight is given to the product by process limitations instantly claimed.

Fibrous crystals

Douglass et al. are silent to the tantalum carbide material comprising a TaC layer formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; wherein the tantalum carbide material comprises TaC layers formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; fibrous crystals within the same TaC layer has the same growing direction; and a growing direction of fibrous crystals within a TaC layer is different from a growing direction of fibrous crystals within a different TaC layer.

However, as mentioned above, the tantalum or tantalum alloy of Douglass is carburized under similar conditions to those instantly claimed and taught, and therefore it is inherent that the tantalum carbide material comprising a TaC layer will have carbon

penetrate the surface of the tantalum or tantalum alloy, and the TaC layer will inherently comprise fibrous crystals within the same TaC layer having the same growing direction; and a growing direction of fibrous crystals within a TaC layer is different from a growing direction of fibrous crystals within a different TaC layer.

Regarding claims 9 and 14, Douglass et al. teach that the Tantalum is fully carburized (Table 2, material 6), thus teaching the penetration of carbon into all areas of the tantalum or tantalum alloy.

Regarding claims 10 and 22, as seen in Figure 2, the carburization results in a first layer of  $Ta_2C$  and a second uppermost layer of TaC (see figure 2 and col. 2, lines 28-40). This multilayer structure reads on the claimed structure.

Regarding claim 13, the claims set forth that the tantalum carbide material is an electrode. While there is no disclosure that the article of Douglass is an “electrode” as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of

performing the intended use, then it meets the claim. Since the material of Douglass et al. has the same structure as instantly claimed, it is not said to provide a structural distinction between the claimed invention and the prior art. The material of Douglass et al. is capable of serving as a free standing electrode, in that an electrode is a conductor, and since the material of Douglass et al. is the same as claimed it is said to also be able to serve the function of a conductor.

Regarding claim 15, the applicant sets forth that the electrode of tantalum carbide is a filament of the tantalum carbide or a heater of the tantalum carbide. These recitations are merely intended use and do not impart any structural limitations to the claims.

The recitation in the claims that the electrode is “a filament” or “a heater” is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner’s position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Douglass et al. disclose the same coated material as presently claimed, it is clear that the article of Douglass et al. would be capable of performing the intended

use, i.e. being a filament or a heater, presently claimed as required in the above cited portion of the MPEP.

Regarding claims 16 and 21, Douglass et al. teach elevated temperature heat treatments at 2300°C (Table 1) in the presence of methane and a carbon crucible in a reduced atmospheric pressure (vacuum). Although this temperature range is just outside the claimed range of less than 2300°C, these product by process limitations are given little patentable weight as the applicant discloses that the claimed structural features are obtained for heat treatments of 1860°C to 2500°C (instant specification, page 10, lines 20-25). Since Douglass teaches, as described above, a heat treatment at 2300°C it is inherent that they will have the same structural features, and therefore little patentable weight is given to the claimed product by process limitations, as they do not provide a structural distinction between the article claimed and that of the prior art.

Regarding claims 17 and 23 as seen in Figure 2, the TaC layer is thicker than the Ta<sub>2</sub>C layer.

Regarding claims 24 and 25, as seen in Figure 2 the tantalum carbide layer has a uniform thickness and is formed over the entire surface.

Claims 8-10, 13-16, 21, 22, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, rejected under 35 U.S.C. 103 (a) as being unpatentable over Lopez et al. (US 5,916,377).

In regards to claim 8, Lopez et al. teach an article that comprises carburized tantalum or tantalum alloys (col. 3, lines 50-55). The carburization occurs under a

vacuum wherein the furnace was evacuated and flushed with argon gas for 3 cycles in order to remove oxygen from the furnace. The carburization occurs at a temperature of 1700°C for about 10 hours (col. 4, lines 5-15). The carbon source in the vacuum is provided from a packed carbon powder.

The applicant claims the article in a product by process form, wherein the process limitations include a vacuum heat treatment under a condition where a native oxide layer of Ta<sub>2</sub>O<sub>5</sub> formed on a surface of the tantalum or tantalum alloy is sublimated to remove the Ta<sub>2</sub>O<sub>5</sub>; as well as heat treating the tantalum or tantalum alloy by introducing a carbon source into the vacuum heat treatment furnace to have carbon penetrate from the surface of the tantalum or tantalum alloy.

#### Ta<sub>2</sub>O<sub>5</sub> Removal

Lopez et al. are silent to removing the native oxide layer of Ta<sub>2</sub>O<sub>5</sub> through sublimation.

However the examiner takes two separate positions in regards to this claim limitation in view of Lopez et al.

The first position is that the processing conditions of a vacuum heat treatment to remove oxygen and a heat treatment while introducing a carbon source, are similar processing conditions to those disclosed by Lopez et al. as mentioned above. Even though Lopez et al. are silent to the instantly claimed removal of native oxide Ta<sub>2</sub>O<sub>5</sub>, it is inherent that this removal would occur in Lopez et al. since they teach substantially the same processing techniques, as well as the evacuation of all oxygen from the furnace.

It has been held that where the claimed and prior art products are identical or substantially identical in structure or are produced by identical or a substantially identical processes, a *prima facie* case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 ( Fed. Cir. 1990). The ***prima facie*** case can be rebutted by evidence showing that the prior art products do not necessarily posses the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Lopez et al. teach elevated temperature heat treatments of 1700°C for 10 hours in the presence of a carbon source in a reduced atmospheric pressure (vacuum), as well as the evacuation of all oxides. These processing parameters substantially overlap those process parameters instantly claimed and therefore it is inherent that the native oxide, Ta<sub>2</sub>O<sub>5</sub>, is removed.

The second position is that these parameters of a heat treatment to remove a native oxide, as well as a heat treatment in a vacuum in the presence of a carbon source are all product by process limitations that do not structurally distinguish themselves, from the prior art.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.", (*In re*

Thorpe, 227 USPQ 964,966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product (In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113).

The instant claims set forth a product with a final structure that comprises a tantalum carbide layer on a tantalum body with no intervening oxide. Lopez et al. do not teach an oxide layer is present and as seen in the figures there is a sharp interface between the carburized tantalum body and the tantalum carbide layers. Therefore it is the Examiner's position that the structure of Lopez et al. is the same as the structure instantly claimed, wherein little to no patentable weight is given to the product by process limitations instantly claimed.

#### Fibrous Crystals

Lopez et al. are silent to the tantalum carbide material comprising a TaC layer formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; wherein the tantalum carbide material comprises TaC layers formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; fibrous crystals within the same TaC layer has the same growing direction; and a growing direction of fibrous crystals within a TaC layer is different from a growing direction of fibrous crystals within a different TaC layer.

However, Lopez et al. teach a heat treatment at 1700°C under vacuum of 1.3 Pa for 10 hours. Applicant teaches a heat treatment of 1800-2300°C under vacuum of less than 1 Pa for 3 hours (instant specification, page 21). These processing parameters are substantially the same, as it is known in the art that heat treatments of lower temperatures but longer time periods will achieve similar results to heat treatments of higher temperatures and shorter time periods. Due to these similar processing conditions and similar materials, it is the examiners position that the prior art material will exhibit the same characteristics as instantly claimed. Therefore it is inherent that the tantalum carbide material comprising a TaC layer formed by having the carbon penetrate the surface of the tantalum or tantalum alloy, wherein the tantalum carbide material comprises TaC layers formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; fibrous crystals within the same TaC layer has the same growing direction; and a growing direction of fibrous crystals within a TaC layer is different from a growing direction of fibrous crystals within a different TaC layer.

Regarding claims 9 and 14, the article of Lopez et al. teach that carbon penetrates the grains of the tantalum material, see Figures 1a, 1b, 2a, and 2b, thus teaching that carbon is penetrated into all areas of the tantalum or tantalum alloy.

Regarding claims 10 and 22, the carburization results in a first layer of Ta<sub>2</sub>C and a second uppermost layer of TaC (col. 4, lines 20-27). This multilayer structure reads on the instant structure of claim 10.

Regarding claim 13, the claims set forth that the tantalum carbide material is an electrode. While there is no disclosure that the article of Lopez is an “electrode” as

presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim. Since the material of Lopez et al. has the same structure as instantly claimed, it is not said to provide a structural distinction between the claimed invention and the prior art. The material of Lopez et al. is capable of serving as a free standing electrode, in that an electrode is a conductor, and since the material of Lopez et al. is the same as claimed it is said to also be able to serve the function of a conductor.

Regarding claim 15, the applicant sets forth that the electrode of tantalum carbide is a filament of the tantalum carbide or a heater of the tantalum carbide. These recitations are merely intended use and do not impart any structural limitations to the claims.

The recitation in the claims that the electrode is “a filament” or “a heater” is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states

that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Lopez et al. disclose the same coated material as presently claimed, it is clear that the article of Lopez et al. would be capable of performing the intended use, i.e. being a filament or a heater, presently claimed as required in the above cited portion of the MPEP.

Regarding claims 16 and 21, Lopez et al. teach elevated temperature heat treatments of 1700°C (Table 1) in the presence of a carbon source in a reduced atmospheric pressure (vacuum). Although this temperature range is just outside the claimed range of greater than 1860°C, Lopez teaches longer heat treatments, and therefore the final structure of Lopez will inherently have the same characteristics as instantly claimed little patentable weight is given to the product by process limitations of claims 16 and 21 as for reasons mentioned above, they are not said to provide a structural distinction between the claimed article and that article of the prior art.

Regarding claims 24 and 25, as seen in the Figures 2a and 2b, the tantalum carbide layer has a uniform thickness and is formed over the entire surface.

Claims 8, 9, 13-16, and 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Garg et al. (US 5,126,206).

Garg et al. teach a tantalum electrode, which is a filament that is carburized through a process that involves a two step heat treatment as instantly claimed. The first heating step includes a heat treatment in a vacuum at 1800 °C. The second heat treatment involves a temperature of 2100°C for 12 hours, in the presence of a carbon source ( $\text{CH}_4$ ) (col. 10, lines 44-65).

Garg et al. are silent to the removal of  $\text{Ta}_2\text{O}_5$  during the first heat treatment. However, it has been held that where the claimed and prior art products are identical or substantially identical in structure or are produced by identical or a substantially identical processes, a *prima facie* case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 ( Fed. Cir. 1990). The ***prima facie*** case can be rebutted by evidence showing that the prior art products do not necessarily posses the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Since this heat treatment taught by Garg is similar to the heat treatment instantly claimed, it is inherent that the tantalum filament will behave in the same manner as instantly claimed, i.e.  $\text{Ta}_2\text{O}_5$  will be removed from the surface of the Ta filament, and furthermore it is inherent that the entire Ta filament in all areas will be penetrated with carbon.

A second position in view of Garg, is that these instantly claimed parameters of a heat treatment to remove a native oxide, as well as a heat treatment in a vacuum in the presence of a carbon source are all product by process limitations that do not structurally distinguish themselves, from the prior art.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.", (In re Thorpe, 227 USPQ 964,966). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product (In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983), MPEP 2113).

The instant claims set forth a product with a final structure that comprises a tantalum carbide layer on a tantalum body with no intervening oxide. Garg et al. do not teach an oxide layer is present and teach that the surface is carburized well. Therefore it is the Examiner's position that the structure of Garg et al. is the same as the structure instantly claimed, wherein little to no patentable weight is given to the product by process limitations instantly claimed.

Fibrous Crystals

Garg et al. are silent to the tantalum carbide material comprising a TaC layer formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; wherein the tantalum carbide material comprises TaC layers formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; fibrous crystals within the same TaC layer has the same growing direction; and a growing direction of fibrous crystals within a TaC layer is different from a growing direction of fibrous crystals within a different TaC layer.

However, as mentioned above, the tantalum or tantalum alloy of Garg is carburized under similar conditions to those instantly claimed and taught, and therefore it is inherent that the tantalum carbide material comprising a TaC layer formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; wherein the tantalum carbide material comprises TaC layers formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; fibrous crystals within the same TaC layer has the same growing direction; and a growing direction of fibrous crystals within a TaC layer is different from a growing direction of fibrous crystals within a different TaC layer.

Regarding claims 16 and 21, the heat treatment of 2100°C falls within the claimed range of 1860°C to 2300°C. Although Garg et al. teach a pressure of 30 torr which is outside the claimed range of less than 1 Pa this limitation is a product by process limitation that is given little patentable weight. Garg teaches similar elevated heat treatments of the same materials claimed, and therefore the carburized tantalum filament will for reasons mentioned above have the same structure as claimed, and therefore little to no patentable weight is given to the product by process limitations. It is

the examiner's position that the difference in pressures will not result in a structural difference between the claimed product and that product of the prior art.

***Allowable Subject Matter***

Claims 11, 12, and 18-20 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record, Lopez et al. and Douglass et al., teaches tantalum carbide crucibles. The prior art of record Garg et al. teaches freestanding filaments. There is no teaching or motivation to form those tantalum carbide materials as a patterned layer on a semiconductor substrate.

***Response to Arguments***

On page 8 of the remarks submitted December 16, 2010, applicant argues that "none of the references (Douglass, Lopez, or Garg) disclose a tantalum carbide material wherein the tantalum carbide material comprises TaC layers formed by having the carbon penetrate the surface of the tantalum or tantalum alloy; fibrous crystals within the same TaC layer has the same growing direction; and a growing direction of fibrous crystals within a TaC layer is different from a growing direction of fibrous crystals within a different TaC layer as in amended Claims 8, 11 and 13."

Applicant argues that "none of the reference disclose a tantalum carbide material obtained by a process where a native oxide layer of  $Ta_2O_5$  formed on a surface of the

tantalum or tantalum alloy is sublimated to remove the Ta<sub>2</sub>O<sub>5</sub> as in as in amended Claims 8, 11 and 13".

In the declaration submitted June 20, 2011 applicant provides examples where if Ta<sub>2</sub>O<sub>5</sub> is not sufficiently removed prior to depositing that TaC layers as in amended claims 8, 11, and 13, that the tantalum carbide does not necessarily and inherently result in the claimed fibrous crystals within the same TaC layer having the same growing direction; and a growing direction of fibrous crystals within a TaC layer being different from that of fibrous crystals within a different TaC layer.

In the declaration submitted June 20, 2011, Applicant provides examples 1 and 2 and their respective comparative examples. The declaration contends that examples 1 and 2 are preformed according to the present invention. However the examiner notes that Examples 1 and 2 actually are not within the scope of the invention as it is performed at a pressure of 10 Pa, whereas the instant invention discloses that the process is performed at a pressure of 1 Pa or lower. (see instant specification pg 16 line 20-pg 17, line 11). Therefore the declaration is not found persuasive.

In regards to comparative example 1, applicant contends that this is performed at similar conditions to Douglass et al. However, a pressure of 10Pa, as preformed in the declaration, is not within the scope of Douglass which teaches that the pressure is between 20 and 50 mm (Hg) (Douglass et al. col. 3, lines 15-20, which equates to 2.6-6.6kPa. Therefore the comparative example 2 is not the same as disclosed by Douglass et al. and is therefore not found persuasive and the rejections over Douglass et al. are therefore maintained.

In regards to comparative example 2 versus example 2 of the declaration submitted June 20, 2011, these comparisons are not a direct comparison, as the temperature of comparative example 2 is performed at 1850 °C while example 2 is preformed at 2000°C. It is unclear if the claimed fibrils are a result of the claimed oxide removal as contended by the applicant or if the fibrils are actually a result of the higher temperature anneal. Therefore the applicant has not persuasively shown that a structural difference occurs due to the oxide removal.

The applicant has not provided any evidence testing Lopez et al.'s or Garg et al.'s processes to show that they do not inherently result in the claimed structural features. Therefore the rejections over Garg and Lopez et al. are maintained.

On pages 8 and 9 of the remarks, applicant argues that inherency as proposed by the Examiner can not be based on probabilities or possibilities. However the Examiner has established a *prima facie* case that the processes claimed and disclosed in the instant specification are substantially the same as those taught in the prior art, therefore the burden is now on the Applicant to show that the claimed structural features are not inherent to the article of the prior art produced by substantially the same processes.

Applicant argues on page 9 of the remarks that none of the references recognize the importance of oxide removal prior to carbon penetration. However, this is not a feature that would patentably distinguish the claimed article from the article of the prior art. For reasons mentioned above, it is the examiner's position that the claimed oxide

removal would be necessarily inherent to the processes disclosed by the prior art as they are substantially the same as those instantly disclosed, and that the claimed fibrils are also a result of the process and therefore inherent to the prior art of record. The applicant has failed to meet their burden in showing that these claimed structural features are not present in the articles of the prior art and therefore the rejections are maintained.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN LANGMAN whose telephone number is (571)272-4811. The examiner can normally be reached on Mon-Thurs 8:00 am - 6:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCL  
/Jonathan C Langman/  
Primary Examiner, Art Unit 1784